

REMARKS

Applicant(s) have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action, mailed October 5, 2005. Reconsideration and reexamination is respectfully requested. Claims 1-15 remain in the application.

The Office Action

Examiner rejected claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Qua (U.S. Patent Number 6,222,909), in view of Bartfeld (U.S. Publication Number 20030086432).

The Subject Invention

By way of review, the subject invention relates to a method and apparatus for providing a network-based voice memo feature. In at least one form, the invention is directed to a system that will provide network-based functionality to allow a user to record a voice memo during an ongoing call, create a voice mail message based on the recorded memo and store the message in the user's voice mailbox for later retrieval. In applying the method comprises maintaining a voice call between a mobile station and another communication device, the voice call having a forward link and reverse link monitoring the reverse link of the voice call, detecting a first code transmitted on the reverse link by the mobile station and opening a connection between the mobile station and a voice messaging system based on the first code. The described method continues with recording voice data transmitted on the reverse link subsequent to the detection of the first code on the voice messaging system through the opened connection, detecting a second code transmitted on the reverse link by the mobile station and finally terminating the connection between the mobile station and the voice messaging system based on the second code.

The Cited Art

Qua (U.S. Patent Number 6,222,909) is an audio note taking system and method. The system enables a user to take multiple audio notes of a specific conversation by starting and stopping a recording device by generating appropriate

control signals from a respective communication device during that conversation. The invention stores the user's memo in a storage unit which will enable the user to forward the message to other storage devices such as e-mail. The storage unit may be detachable and can be connected using a socket interface, a cable or other similar technique or it may be in the network itself.

Bartfeld (U.S. Publication Number 20030086432) is telephone call management system. The invention allows for call review where a voice mail message being recorded for a specific telephone may be played on a television associated therewith during the time it is being recorded. Optionally, the call may further be retrieved and rerouted to the user telephone responsive to a command entered via the television distribution gateway, and any call may be recorded responsive to commands entered via the gateway.

The Pending Claims 1-15 are Not Obvious Over Qua in View of Bartfeld.

The Examiner rejected claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over Qua in view of Bartfeld. Applicants respectfully traverse for the following reasons.

There Is No Motivation to Combine Qua and Bartfeld

First, there is no motivation to combine the two references. In order to properly combine references under 35 U.S.C. §103, there must be some suggestion or motivation to modify or combine reference teachings. MPEP §2143.01. Here it is submitted that there is no motivation to combine the teachings of Qua and Bartfeld. The Examiner states that one would have been motivated to combine the references in order to reduce the processing steps and to implement a cost-effective system by reducing hardware expenditures. However, in this case, there was no motivation to combine the references because Qua teaches away from such a combination. Such a modification would render Qua unsatisfactory for its intended purpose. Furthermore, the proposed modification changes the principle of operation of the Qua reference.

More particularly, if the proposed combination of the prior art would change the principle of operation of the prior art invention being modified, the teachings of the

references are not sufficient to render the claims *prima facie* obvious. MPEP §2143.01 *In re Ratti*, 270 F2d 810, 123 USPQ 349 (CCPA 1959). In addition, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. MPEP § 2143.01.

In that regard, Qua's principle purpose is to store the audio note in a manner such that it can be processed and distributed in different formats. See Fig. 3, Col.1 Line 34 -37. Qua does this by storing the audio notes in an audio note taking mechanism which can be used to distribute the audio note. It is the audio note taking mechanism that determines what type of processing is required in order to accomplish this task. For example, it is the audio note taking mechanism that determines, based on user input, whether the audio note should be processed as an audio file or sent to a speech recognition processor to be converted to a text file. The audio note taking mechanism would also determine if the audio note would be compressed before it is sent to a personal computer. Under the proposed combination, the audio note would bypass the audio note taking mechanism and the principal operation of Qua would not only be significantly altered, but Qua would be rendered unsatisfactory. Opening and then closing a connection between the mobile phone and voicemail would make it more difficult, if not impossible, to manipulate the message, as suggested in Qua.

Moreover, Qua expressly teaches away from the teaching of Bartfeld, stating that such communication techniques are ineffective because, in order to gain full advantage of the portable/wireless devices, they are being used in non-traditional environments outside the home or office. See Col. 1 lines 14 – 22. On the other hand, Bartfeld can only be used where the user has subscribed to a television service, most commonly at the user's home. When prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. MPEP §2343.01. Here, the Qua reference discredits and teaches away from the teachings of Bartfeld.

The Combination of Bartfeld and Qua Does Not Disclose All of The Elements In the Claimed Invention

Even assuming the propriety of the combination, the pending claims 1-15 are not obvious over Qua in view of Bartfeld. In order to establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art. MPEP 2143.03.

First, with regards to claims 1, 6 and 11, Examiner has stated that one skilled in the telecommunications art would realize that the voice call in Qua's method would have a forward link and a reverse link in which the reverse link being a link from a mobile station to a base station. However, support for such an assertion is necessary under MPEP §2144.03. Here, there is no support provided by the Examiner. Nonetheless, even if one assumes that Qua's method would include a forward link and reverse link, Qua does not expressly disclose that the system monitors the reverse link and detects the signals transmitted on the reverse link. Therefore, because neither reference discloses monitoring the reverse link and detecting signals transmitted on the reverse link, the combination does not disclose all of the elements in the claimed invention.

Further regarding claims 1, 6 and 11, neither Qua, Bartfeld, nor the combination of the two, disclose the step of opening a connection between the mobile station and a voice messaging system. As Examiner has previously stated, Qua does not teach the opening of a connection between the mobile station and a voice mailbox messaging system based on the first code.

Contrary to the Examiner's assertions, the combination also does not disclose such a step. It is submitted that Bartfeld also does not disclose the aforementioned step. If, as the Examiner suggests, the Network Storage of Qua was replaced with the VMS of Bartfeld, the result would still not involve opening a connection as claimed. As disclosed in Qua, the recording is not done by opening and closing a connection but instead by appending the call to memory 208. (Fig. 2) Therefore, the combination as suggested by the Examiner does not disclose or suggest the claim as written and withdrawal is respectfully requested.

Accordingly, independent claims 1, 6 and 11 are not rendered obvious by the suggested combination. Likewise, claims 2-5, 7-10 and 12-15 - - all dependent on the

noted independent claims - - are allowable.

In addition, referring now to claims 2, 7 and 12, validating the mobile station is not disclosed, nor is it suggested in the combination of Qua and Bartfeld. As defined in the specification, validating the mobile station involves determining if the user is a subscriber. Contrary to the Examiners assertion, verifying if the user has enabled a private mode function does not read on determining if the user is a subscriber. The verification process includes accessing the subscriber data field in the mobile subscriber database and verifying that the user has subscribed to the service. Because the proposed combination of Qua and Bartfeld neither discloses nor suggests validating the mobile station, it is respectfully requested that this rejection is withdrawn.

Further, regarding claims 3, 4, 8, 9, 13 and 14, the Examiner asserts that one skilled in the art would realize that stored recorded voice data would have been identified and stored in a voice mailbox in order to retrieve the targeted message in modified Qua's system. However, the Examiner has once again failed to support the assertion with any evidence. It is not appropriate to rely solely on common knowledge in the art without evidentiary support. MPEP § 2144.03 Again, documentary evidence to support Examiner's conclusion is respectfully requested or in the alternative, this rejection should be withdrawn.

Referring now to claims 5, 10 and 15, as stated above, it is impermissible to add features not disclosed in the cited references without specific factual findings or concrete evidence that the features are common knowledge to those skilled in the art. Examiner has not cited any references disclosing a voice memo control module, a first or second communication path or a voice handler. Therefore, it is respectfully requested that the rejections to claims 5, 10 and 15 be withdrawn.

CONCLUSION

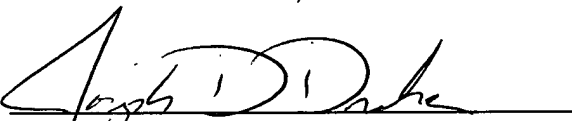
For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-15) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone Joseph Dreher, at (216) 861-5582.

Respectfully submitted,

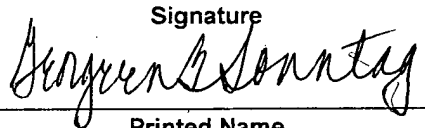
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April 5, 2006
Date


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CERTIFICATE OF MAILING

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